APPEAL BRIEF
Serial Number: 09/945,099
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 1
Dkt: 0006-003004

<u>**S/N 09/945,099**</u>   **PATENT**
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Timothy Orr Knight	Examiner: Peng Ke
Serial No.:	09/945,099	Group Art Unit: 2174
Filed:	August 31, 2001	Docket No.: 0006-003004
Title:	INTERFACE AND METHOD ADAPTED FOR CAPTURING SUBJECTIVE PREFERENCES OF PROGRAM USERS	

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
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Alexandria, VA 22313-1450

This Appeal Brief is submitted in support of the Notice of Appeal filed February 26, 2007.

I.   <u>REAL PARTY IN INTEREST</u>

Maquis Techtrix, LLC is the real party in interest.

II.   <u>RELATED APPEALS AND INTERFERENCES</u>

To the best knowledge of Appellant, Appellant's legal representative, and Appellant's assignee, there are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on a decision by the Board of Patent Appeals and Interferences ("the Board") in the pending appeal.

III.   <u>STATUS OF CLAIMS</u>

Claims 42-52 and 91-145 are pending in this appeal, in which claims 1-41 and 53-90 have earlier been canceled. No claim is allowed. This appeal is therefore taken from the final rejection of claims 42-52 and 91-145 on August 23, 2006.

IV.   STATUS OF AMENDMENTS

No amendment to the claims has been filed subsequent to the final rejection of claims 42-52 and 91-145 on August 23, 2006.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 42 relates to an electronic interface for collecting information for a data picture that includes a data palette providing a set of data parameters available for selection, said set of data parameters including at least some corresponding to predefined statements concerning an action and/or a transaction (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; FIG. 1 (115A); FIG. 2 (200, 210, 205)); and a data canvas (*see, e.g.,* specification, p. 6, ll. 7-9; p. 9, ll. 26-27; FIG. 1 (115B); FIG. 2 (215)) on which a selected set of one or more of said set of data parameters can be displayed and relatively positioned arbitrarily by a user to generate the data picture (*see, e.g.,* specification, p. 6, ll. 7-9; p. 6, ll. 16-20; p. 9, ll. 8-19; FIG. 1 (120); FIG. 2 (230)) wherein the data picture includes a display of a graphical relative positioning of the selected set of data parameters relative to one another, the graphical relative positioning being configured by the user within the data canvas (*see, e.g.,* specification, p. 6, ll. 9-11; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 2 (210)).

Dependent claim 43 relates to the interface of claim 42, wherein said selected set of data parameters can be selected and physically moved by such user to a gradient on said data canvas by physically manipulating an electronic pointing device (*see, e.g.,* specification, p. 6, ll. 7-11; p. 6, ll. 16-20; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 1 (120); FIG. 2 (210, 230)).

Dependent claim 44 relates to the interface of claim 42, wherein the data picture is generated using a single data capture screen including said data palette and said data canvas (*see, e.g.,* specification, p. 6, ll. 7-11; p. 6, ll. 16-20; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 1 (120); FIG. 2 (210, 230)).

Dependent claim 46 relates to the interface of claim 45, wherein said numeric data values are based on the physical location of said selected set of data parameters as placed by the user on said data canvas (*see, e.g.,* specification, p. 6, ll. 23 – p. 7, l. 4; p. 9, ll. 15-20; p. 16, ll. 5-6).

Dependent claim 47 relates to the interface of claim 42, wherein said selected set of data parameters, including individual ones of said selected group of predefined statements can be ranked in relative importance by the user based on their location on said data canvas (*see, e.g.,* specification, p. 6, ll. 7-11; p. 6, ll. 16-20; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 1 (120); FIG. 2 (210, 230)).

Independent claim 91 relates to a computer program product including a signal bearing medium bearing at least one of one or more instructions for providing a data palette, said palette including a set of data parameters available for selection by a user, such that said set of data parameters includes at least some corresponding to predefined statements concerning an action and/or a transaction (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; FIG. 1 (115A); FIG. 2 (200, 210, 205)); and one or more instructions for providing a data canvas on which selected data parameters can be displayed and relatively positioned arbitrarily by said user to generate a data picture (*see, e.g.,* specification, p. 6, ll. 7-9; p. 6, ll. 16-20; p. 9, ll. 8-19; FIG. 1 (120); FIG. 2 (230)) wherein the data picture can be based at least in part on a graphical relative positioning of a selected group of said predefined statements collected from said user and pertaining to the user's mental impressions concerning said action and/or said transaction, said graphical relative positioning being configured by the user within the data canvas based on physical positions selected by the user within the data canvas for said predefined statements and/or a relative spatial relationship between said predefined statements within the data canvas concerning said action and/or said transaction (*see, e.g.,* specification, p. 6, ll. 9-11; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 2 (210)).

Independent claim 99 relates to a method of permitting a user to input a data picture expressing mental impressions concerning an action and/or transaction (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; FIG. 1 (115A); FIG. 2 (200, 210, 205)). The method includes providing a set of a plurality of individual assertions, said assertions being associated with such mental impressions; displaying said set of assertions to the

user in a first portion of a visible electronic interface (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; FIG. 1 (115A); FIG. 2 (200, 210, 205)); and permitting the user to select and move personalized individual assertions taken from said sets of assertions to a second, separate portion of said visible interface, which second separate portion acts as a data canvas for displaying such personalized individual assertions (*see, e.g.,* specification, p. 6, ll. 7-9; p. 9, ll. 26-27; FIG. 1 (115B); FIG. 2 (215)); and wherein said personalized individual assertions can be relatively positioned by the user relative to one another within the data canvas to create the data picture (*see, e.g.,* specification, p. 6, ll. 9-11; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 2 (210)).

Independent claim 106 relates to a method of capturing data concerning an actual or proposed transaction from the user of a computing system (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; FIG. 1 (115A); FIG. 2 (200, 210, 205)), said system including at least a keyboard and pointing device for inputting data. The method includes providing a set of a plurality of individual assertions, said assertions being associated with mental impressions of the user relating to the transaction (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; FIG. 1 (115A); FIG. 2 (200, 210, 205)); displaying said sets of assertions to the user in a first portion of a visible electronic interface (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; FIG. 1 (115A); FIG. 2 (200, 210, 205)); permitting the user to select and move the selected assertions taken from said set of assertions to a second, separate portion of said visible interface, which second separate portion acts to display such selected assertions along a visible gradient (*see, e.g.,* specification, p. 6, ll. 7-9; p. 6, ll. 16-20; p. 9, ll. 8-19; FIG. 1 (120); FIG. 2 (230)); and permitting the user to relatively position said selected assertions in a ranking order relative to each other along said visible gradient to create a data picture (*see, e.g.,* specification, p. 6, ll. 9-11; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 2 (210)).

Independent claim 111 relates to a method of generating program data from user input data concerning an actual or proposed action and/or transaction. The method includes providing the user with a palette of individual assertions associated with the user's perceptions of such

action and/or transaction in a first portion of a visible interface (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; FIG. 1 (115A); FIG. 2 (200, 210, 205))); permitting the user to select and move selected assertions taken from said set of assertions to a second, separate portion of said visible interface, which second separate portion acts to visibly display such selected assertions (*see, e.g.,* specification, p. 6, ll. 7-9; p. 9, ll. 26-27; FIG. 1 (115B); FIG. 2 (215)); permitting the user to relatively position said selected assertions in a ranking order relative to each other so as to constitute the user input data (*see, e.g.,* specification, p. 6, ll. 7-11; p. 6, ll. 16-20; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 1 (120); FIG. 2 (210, 230)); and converting the user input data into program data, by assigning numerical values to such program data corresponding to said relative positioning of said selected assertions (*see, e.g.,* specification, p. 6, ll. 21 – p. 7, . 4; p. 9, ll. 17-21; p. 15, l. 23 – p. 16, l. 28; FIG. 1 (125)).

Independent claim 121 relates to a method of capturing input data from a user within an electronic interface including (a) providing a menu within the interface for presenting a set of data parameters to the user (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; FIG. 1 (115A); FIG. 2 (200, 210, 205)); (b) providing a canvas in association with the interface for creating a data record based on said set of data parameters (*see, e.g.,* specification, p. 6, ll. 7-9; p. 9, ll. 26-27; FIG. 1 (115B); FIG. 2 (215)); (c) moving a selected data parameter from the set of data parameters to said canvas (*see, e.g.,* specification, p. 6, ll. 7-9; p. 9, ll. 26-27; FIG. 1 (115B); FIG. 2 (215)); and (d) relatively positioning said selected data parameter on said canvas so as to indicate a corresponding weighting factor to be associated with said selected data parameter (*see, e.g.,* specification, p. 6, ll. 7-11; p. 6, ll. 16-20; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 1 (120); FIG. 2 (210, 230)).

Independent claim 126 relates to a method of providing feedback to a user during a data input session. The method includes (a) collecting input data from the user using a data interface, said input data including i) one or more selected data parameters (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; FIG. 1 (115A); FIG. 2 (200, 210, 205)); ii) weighting information identifying a corresponding weighting factor to be given to each of said one or more selected data parameters (*see, e.g.,* specification, p. 6, ll. 7-11; p. 6, ll.

16-20; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 1 (120); FIG. 2 (210, 230)); and (b) providing feedback information to the user while the user is providing said input data, said feedback information being based at least in part on said input data such that the user can monitor the effect of changing said one or more selected data parameters and/or their associated weighting factors based on relative positioning of each of the selected data parameters by the user (*see, e.g.,* specification, p. 7, ll. 14-18; p. 17, l. 27 – p. 19, l. 1; FIG. 2 (260)).

Dependent claim 128 relates to the method of claim 126, wherein said data input session is conducted using a Java™ applet operating within an Internet browser (*see, e.g.,* specification, p. 5, l. 2 - p. 7, l. 26, FIGS. 1, 2).

Independent claim 131 relates to a method of evaluating data records associated with an action and/or transaction. The method includes (a) storing one or more data records (*see, e.g.,* specification, p. 6, ll. 21-23; p. 9, ll. 17-20; p. 15, l. 23 – p. 16, l. 17; FIG. 1 (130)), each of said data records including i) a set of data parameters identified by a user as pertaining to the action and/or transaction (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; FIG. 1 (115A); FIG. 2 (200, 210, 205)); ii)   a weighting factor to be given to each data parameters in said set of data parameters based on a relative positioning of each of the data parameters by the user (*see, e.g.,* specification, p. 6, ll. 7-11; p. 6, ll. 16-20; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 1 (120); FIG. 2 (210, 230)); (b) processing a query by the user, said query requesting an evaluation of a frequency of usage for a data parameter, and/or an evaluation of a rating given to a weighting factor associated with said data parameter, across said data records or a subset thereof (*see, e.g.,* specification, p. 17, ll. 18-21; p. 17, l. 27 – p. 18, l. 2; p. 18, ll. 6-29); and (c) providing feedback to the user in response to said query (*see, e.g.,* specification, p. 17, ll. 21-25; p. 17, l. 27 – p. 19, l. 29).

Independent claim 136 relates to a method of creating a data record based on input data from a user provided with an interface (*see, e.g.,* specification, p. 16, ll. 5-28; FIG. 1 (115A, 115B, 120, 125, 130)). The method includes (a) generating a first data picture at a first time within the interface, said first data picture including a first set of data parameters and associated weighting factors, wherein said first data picture is created before the user performs an action

and/or transaction associated with said first set of data parameters (*see, e.g.,* specification, p. 16, ll. 5-22; p. 19, ll. 10-18); (b) generating a second data picture at a second time within the interface, said second data picture including a second set of data parameters and associated weighting factors based on a relative positioning of each of the second set of data parameters by the user, wherein said second data picture is created after the user performs said action and/or said transaction (*see, e.g.,* specification, p. 17, l. 27 – p. 18, l. 6; p. 19, ll. 18-29); and (c) modifying said second data picture at a third time within the interface using said second set of data parameters, wherein both said first data picture and said second picture are used to create a data record (*see, e.g.,* specification, p. 20, ll. 1-18).

Dependent claim 137 relates to the method of claim 136, wherein said first data picture is not alterable after it is created (*see, e.g.,* specification, p. 19, ll. 16-26).

Dependent claim 138 relates to the method of claim 136, wherein said action and/or transaction pertains to trading a security, and said first data picture is associated with the purchase of said security, and said second data picture is associated with a sale of said security (*see, e.g.,* specification, p. 10, ll. 4-13; p. 19, ll. 23-26).

Dependent claim 139 relates to the method of claim 138, further including providing feedback to the user to indicate a financial performance associated with said trading of said security (*see, e.g.,* specification, p. 10, ll. 4-13; p. 19, l. 23 - p. 20, l. 18).

Independent claim 141 relates to a data picture record derived from data input in the form of a graphical arrangement by a user (*see, e.g.,* specification, p. 16, ll. 5-28; FIG. 1 (125)). The data picture record includes an identifier indicating a particular action and/or a transaction identified by the user as related to the data input (*see, e.g.,* specification, p. 5, l. 27 – p. 6, l. 7; p. 8, ll. 15-26; p. 9, ll. 23-25; p. 10, l. 4 – p. 11, l. 16; p. 15, l. 29 – p. 16, l. 8; FIG. 1 (115A); FIG. 2 (200, 210, 205)); an identity of a data parameter selected by the user to express the data input and used in the graphical arrangement for the particular action and/or transaction (*see, e.g.,* specification, p. 6, ll. 21-29; p. 15, l. 29 – p. 16, l. 8); and a weighting factor associated with said data parameter, said weighting factor being derived from a relative placement of said data parameter within the graphical arrangement (*see, e.g.,* specification, p. 6, ll. 7-11; p. 6, ll. 16-20; p. 6, l. 26 – p. 7, l. 13; p. 9, ll. 8-19; p. 11, l. 16 – p. 12, l. 19; p. 15, ll. 2-22; p.16, ll. 18-28; p. 19, ll. 2-29; FIG. 1 (120); FIG. 2 (210, 230)).

APPEAL BRIEF
Serial Number: 09/945,099
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 8
Dkt: 0006-003004

Dependent claim 142 relates to a data picture of claim 141, wherein a collection of data picture records are grouped for said action and/or transaction (*see, e.g.,* specification, p. 16, ll. 5-28; p. 19, ll. 10-29).

The example references to the specification and drawings enumerated herein are believed to provide a "concise explanation of the subject matter" of the enumerated claims, at least with regard to the patents cited by the Examiner in the rejections of the claims. The example references to the specification and drawings enumerated herein are not intended to be exhaustive of all explanations of the subject matter defined by the claims that is provided by the specification and drawings, as such exhaustive enumeration may involve citing almost all of the specification and drawings for several claims.

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 141-143 are anticipated under 35 U.S.C. 102(b) by U. S. Patent No. 5,819,028 to *Manghirmalani et al.* (Manghirmalani).

Whether claims 42-45, 48-52, 91-94, 98-101, 105-108, 110, 111, 113-123, 126, 127, 129, 131-134, 136, and 140 are obvious under 35 U.S.C. § 103 (a) based on *Manghirmalani et al.* in view of U.S. Patent No. 6,256,651 to *Tuli et al.* (Tuli).

Whether claims 46, 47, 95-97, 102-104, 109, 112, 124, 125, 130, 135, 144, and 145 are obvious under 35 U.S.C. § 103 (a) based on *Manghirmalani et al.* and *Tuli et al.* in view of U.S. Patent No. 6,064,984 to *Ferguson et al.* (Ferguson).

Whether claims 138 and 139 are obvious under 35 U.S.C. § 103 (a) based on *Manghirmalani et al.* and *Tuli et al.* in view of U.S. Patent No. 6,012, 042 to *Black et al.* (Black).

Whether claim 137 is obvious under 35 U.S.C. § 103 (a) based on *Manghirmalani et al.* and *Tuli et al.* in view of U.S. Patent No. 6,055,514 to *Wren*.

Whether claim 128 is obvious under 35 U.S.C. § 103 (a) based on *Manghirmalani et al.* and *Tuli et al.* in view of U.S. Patent No. 6,539,361 to *Richards*.

VII.   ARGUMENT

A.   *MANGHIRMALANI ET AL.* FAILS TO ANTICIPATE CLAIMS 141- 143.

To anticipate a patent claim, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

1.   Independent claim 141 is not anticipated by *Manghirmalani et al.*

Regarding the rejection of independent claim 141 under 35 U.S.C. 102(b) as being anticipated by *Manghirmalani et al.*, Appellant respectfully submits that *Manghirmalani et al.* does not disclose or suggest all of the features recited in claim 141.

For example, claim 141 recites:

> "A data picture record derived from data input in the form of a graphical arrangement by a user, the data picture record comprising:
> an identifier indicating a particular action and/or a transaction identified by the user as related to the data input;
> an identity of a data parameter selected by the user to express the data input and used in the graphical arrangement for the particular action and/or transaction; and
> a weighting factor associated with said data parameter, said weighting factor being derived from a relative placement of said data parameter within the graphical arrangement."

In stark contrast, *Manghirmalani et al.* (per Abstract) is directed to an apparatus that provides a user with an indication of a computer network's health. The indication is provided by a network management station on the computer network. The network management station has a distributable piece of code which instructs agents to gather diagnostic and status information. The network management station then evaluates the network specific diagnostic and status data gathered by the agents. Based on the evaluation, the network management station generates a

representation of the computer network's functionality (i.e., its "health"). Thereby, the user can readily determine whether the computer network requires repairs.

At col. 7, lines 56-67, *Manghirmalani et al.* states:

> In the currently preferred embodiment of the present invention, in addition to providing the health of the overall system, the health of an individual device on the network can also be provided. Furthermore, the weights assigned to each type of network specific data can be varied, depending on the end user's preferences. In other words, the impacts of the utilization, collision rate, and error rate on the overall health score can be varied by the end-user. In addition, the end-user can choose the formulas to be applied in calculating the health score. If the end-user chooses not to input any specific formulas, the present invention provides a list of default formulas.

Thus, *Manghirmalani et al.* mentions that the end-user could vary "the impacts of the utilization, collision rate, and error rate on the overall health score" based on varying weights assigned to each type of network specific data. At col. 12, lines 16-43, *Manghirmalani et al.* states:

> FIG. 12 illustrates a window used to modify the settings for a particular meter type. Formula name 1201 displays the selected meter type. Formula 1202 is comprised of a scroll box 1203 which contains the formula to be applied to the selected meter type 1201. MIB objects/meters 1204 is comprised of a scroll box 1205 which contains a list of MIB objects or meter types which are used in the meter formula 1202. An "*" indicates that the MIB object/meter type is currently being used in the formula. Removal of an MIB object/meter type is accomplished by pointing an [*sic*] clicking a cursor on the desired MIB object/meter in scroll box 1205. Device Type Field 1206 contains the network device type associated with the selected meter type. Display type 1207 indicates the style of the meter (dial, graph, or digital). History interval 1208 specifies the frequency that the current values are to be stored for historical data. Polling interval 1209 specifies the frequency that the meter values are updated and the display is refreshed. Max value 1210 is the theoretical maximum value of the meter. Green range 1211, yellow range 1212, and red range 1213 are fields which specify the range of meter values defining when the meter valves are in the green, yellow, and red areas respectively. The value of these fields are expressed as a percentage of the maximum meter value. The settings for a meter type can be modified by making the necessary edits in the modify window 1200. Clicking the Apply button 1214 will save the changes to the configuration file. Clicking the Dismiss button 1215 will cause the changes to be ignored.

The Examiner (Office Action dated August 23, 2006, page 3, lines 1-4) contends that "a weighting factor associated with said data parameter, said weighting factor being derived from a relative placement of said data parameter within the graphical arrangement" was taught by *Manghirmalani et al.* at FIG. 12, item 1203, the Examiner stating, "A data parameter's placement within the equation determines the relative factor of the data parameter." As best understood, the Examiner equates the MIB Objects/Meters shown in the formula 1202's scroll box 1203 with the "data parameter" recited by claim 141. Further, the Examiner apparently equates the ordering of the MIB Objects/Meters shown in the scroll box 1203 with the "graphical arrangement" recited by claim 141. However, there is no "weighting factor" associated with any of the MIB Objects/Meters as shown in the formula 1202's scroll box 1203, and thus there is further no "weighting factor being derived from a relative placement of said data parameter within the graphical arrangement" disclosed by *Manghirmalani et al.*. To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co., supra; Scripps Clinic & Research Foundation v. Genentech, Inc., supra*. As *Manghirmalani et al.* fails in this regard, the rejection of claim 141 should be withdrawn.

The Examiner (Advisory Action dated December 26, 2006, p. 2, ll. 5-8) further states:

> Manghirmalani teaches assigning weight factors to the parameters because a user may assign factors to the parameters with in the equation. (see Manghirmalani, column 7, lines 55-70) For example, in figure 12, the parameters in the formula are given equal weight because there is no factor multiples to any of the parameters. (see Manghirmalani, figure 12, items 1203) However, when users want to assign different weight factors, the users can multiply the parameter with a factor.

Appellant respectfully submits that this assertion by the Examiner is factually incorrect, and thus, is without basis. *Manghirmalani et al.*, at col. 7, ll. 56-67, merely mentions that "weights assigned to each type of network specific data can be varied," and then states, "In other words, the impacts of the utilization, collision rate, and error rate on the overall health score can be varied by the end-user." Thus, this reference by *Manghirmalani et al.* is to weights assigned to the types of network specific data, i.e., to the types utilization, collision rate, and error rate in formulas for determining health scores. In stark contrast, figure 12, item 1203 of *Manghirmalani*

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et al. shows a formula listing of MIB objects or meter types used in a formula to be applied for an "error rate" meter type for an "Ethernet Concentrator" device type (*See, e.g.,* col. 12, ll. 16-29). Thus, the "weights" mentioned at col. 7, ll. 56-67 were intended to be assigned, for example, to an "error rate," which is not shown, and <u>not</u> to elements of the meter formula 1202 (1203), as urged by the Examiner. There was no disclosure by *Manghirmalani et al.* of any provision for an end user to "assign different weight factors" so that "the users can multiply the parameter with a factor" with reference to FIG. 12, item 1203 as stated by the Examiner (Advisory Action dated December 26, 2006, p.2, ll. 5-8).

Further, the Examiner (Advisory Action dated December 26, 2006, p. 2, ll. 9-11) states:

> Manghirmalani assigns priority to parameters with relative position. (see Manghirmalani, column 7, lines 55-70) The parameters are given different priority based on their position in the formula. (see Manghirmalani, figure 12, items 1203) Whether the parameter is next to a multiply sign or a plus determines its relative weight within the equation.

Appellant respectfully submits that this assertion by the Examiner is not proper as a basis for rejecting claim 141. As best understood, the Examiner (Office Action dated August 23, 2006, p. 3, ll. 1-4; Advisory Action dated December 26, 2006) equates the MIB Objects/Meters shown in the formula 1202's scroll box 1203 with the "data parameter" recited by claim 141. Further, the Examiner (Office Action dated August 23, 2006, p. 3, ll. 1-4, and Advisory Action dated December 26, 2006) apparently equates the ordering of the MIB Objects/Meters shown in the scroll box 1203 with the "graphical arrangement" recited by claim 141. However, claim 141 recites, "A data picture record derived from <u>data input in the form of a graphical arrangement by a user</u>," and there is no indication by the Examiner (Office Action dated August 23, 2006, p. 2, ll. 15-16; Advisory Action dated December 26, 2006) that *Manghirmalani et al.* discloses any of the MIB Objects/Meters of FIG. 12, item 1203 as any type of "<u>data input in the form of a graphical arrangement by a user</u>." In fact, the only reference by *Manghirmalani et al.* of any type of input from the user regarding the MIB Objects/Meters of item 1203 states (col. 12, ll. 24-26), "Removal of an MIB object/meter type is accomplished by pointing an clicking a cursor on the desired MIB object/meter in scroll box 1205." However, even this reference does not disclose any type of "<u>data input in the form of a graphical arrangement by a user</u>."

APPEAL BRIEF
Serial Number: 09/945,099
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 13
Dkt: 0006-003004

Well-settled case law holds that the words of a claim must be read as they would be interpreted by those of ordinary skill in the art. *In re Baker Hughes Inc.,* 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000); *In re Morris,* 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); M.P.E.P. 2111.01. "Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach." *In re Cortright,* 165 F.3d 1353, 1369, 49 USPQ2d 1464, 1465 (Fed. Cir. 1999).

A prior art reference anticipates a patent claims if it discloses every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber,* 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). "Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates." *MEHL/Biophile Int'l Corp. v. Milgraum,* 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999).

Unless the patent otherwise provides, a claim term cannot be given a different meaning in the various claims of the same patent. *Georgia Pacific Corp. v. U.S. Gypsum Co.,* 195 F.3d 1322, 1331, 52 USPQ2d 1590, 1598 (Fed. Cir., Nov. 1, 1999); see also *Southwall Tech., Inc. v. Cardinal IG Co.,* 54 F.3d 1570, 1579, 34 USPQ2d 1673, 1679 (Fed. Cir. 1995) (holding that claim term found in different claims must be interpreted consistently); *Fonar Corp. v. Johnson & Johnson,* 821 F.2d 627, 632, 3 USPQ2d 1109, 1113 (Fed. Cir. 1987) (holding that a term used in one claim had the same meaning in another claim).

Thus, in light of the arguments presented above and in the Response mailed on November 22, 2006 (p. 2, l. 18 – p. 4, l. 27), the rejection of independent claim 141 is not proper and is without basis, and should therefore be reversed.

2. Dependent claims 142 and 143 are not anticipated by *Manghirmalani et al.*

The rejections of dependent claims 142-143 should be reversed for at least the same reasons as independent claim 141, and as the claims are separately patentable on their own merits, as argued in the Response mailed on November 22, 2006 (p. 4, l. 28 – p. 5, l. 4).

APPEAL BRIEF
Serial Number: 09/945,099
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 14
Dkt: 0006-003004

For example, claim 142 recites, "wherein a collection of data picture records are grouped for said action and/or transaction." The Examiner (Office Action dated August 23, 2006, page 3, lines 5-7) contends that this feature is taught by *Manghirmalani et al.* at col. 7, line 55- col. 8, line 8. However, this portion of *Manghirmalani et al.* merely mentions that an end-user can vary "the impacts of the utilization, collision rate, and error rate on the overall health score" based on varying weights assigned to each type of network specific data. There is no disclosure or suggestion of any "collection of data picture records" that are "grouped" for any "action and/or transaction" as recited by claim 142. To anticipate a patent claim, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co., supra; Scripps Clinic & Research Foundation v. Genentech, Inc., supra.* The Examiner has failed to meet this burden with regard to claim 142. Thus, the rejection of claim 142 should be reversed.

By virtue of its dependency on allowable dependent claim 142, dependent claim 143 is allowable for at least the same reasons as claim 142, and is separately patentable on its own merits. Thus, the rejection of claim 143 should also be reversed.

B.   CLAIMS 42-45, 48-52, 91-94, 98-101, 105-108, 110, 111, 113-123, 126, 127, 129, 131-134, 136, and 140 ARE NOT RENDERED OBVIOUS BY *MANGHIRMALANI ET AL.* IN VIEW OF *TULI ET AL.*

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed .Cir. 1997); *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If

an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

"Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. *See In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ([R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.)." *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., April 30, 2007)

Obviousness rejections may require some evidence in the prior art of a teaching, motivation, or suggestion to combine and modify the prior art references. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Regarding the rejections of independent claims 42, 91, 99, 106, 111, 121, 126, 131, and 136 under 35 U.S.C. 103(a) as being unpatentable over *Manghirmalani et al.* in view of *Tuli et al.*, Appellant respectfully submits that *Manghirmalani et al.* in view of *Tuli et al.* does not disclose or suggest all of the features recited in the above-listed independent claims, nor in their respective dependent claims.

1. **Independent claim 42 and dependent claims 43-44 are not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.***

   a. **Independent claim 42 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.***

For example, independent claim 42 recites:

> "An electronic interface for collecting information
> for a data picture, the interface comprising:

a data palette providing a set of data parameters
available for selection, said set of data parameters including
at least some corresponding to predefined statements
concerning an action and/or a transaction; and

a data canvas on which a selected set of one or more
of said set of data parameters can be displayed and
relatively positioned arbitrarily by a user to generate the
data picture,

wherein the data picture includes a display of a
graphical relative positioning of the selected set of data
parameters relative to one another, the graphical relative
positioning being configured by the user within the data
canvas."

Appellant respectfully submits that the dial meters 1301 (and/or 1302 and/or 1303) of FIG. 13 of *Manghirmalani et al.* have nothing to do with any type of "data picture wherein the data picture includes a display of a graphical <u>relative positioning</u> of the selected set of data parameters relative to one another, the graphical <u>relative positioning</u> being configured by the user within the data canvas" as recited by independent claim 42. The Examiner (Office Action dated August 23, 2006, page 4, lines 14-15) correctly acknowledges that "Manghirmalani fails to teach displaying graphically relative positioning of the selected set of parameters," and relies on *Tuli et al.* to compensate for the deficiencies of *Manghirmalani et al.*

Tuli et al. (per Summary) is directed to a workflow system wherein data input by a user into a spreadsheet is computer generated into a bar chart. The system makes available to a user a graphical display of a priority time management system. There are two windows available to a user. The first window, referred to as the "spreadsheet window," is primarily used for inputting data. The second window, referred to as the "bar chart window," is primarily an output window. The output is determined by the criteria of the "spreadsheet window." The "spreadsheet window" contains a spreadsheet which is divided into multiple rows and columns. The first five columns are labeled as follows: "To-do" item, Priority, Time, Continuous, Deadline. A user inputs into the cells of each column the required data.

The "bar chart" window contains a bar graph. The bar graph consists of a y-axis and an x-axis. The "To-do" items are listed vertically along the y-axis, and the x-axis is time. The x-axis is divided into blocks representing days; each block is further divided into equal segments

representing the hours of a typical work day. The bars are plotted according to the variables
Priority, Time, and Deadline from the spreadsheet. The bars indicate when a user is to begin and
to finish the corresponding task. Tasks which are "discontinuous" are divided into various
segments of time, and spread over the days leading up to the deadline. The bars are color coded
such that each "To-do" item has a distinct color based upon its priority.

Tuli et al., at col 7, lines 30-48, discusses a user adjusting a priority of a task in the
spreadsheet window, which results in a regeneration of the bar graph in the bar chart window,
with an adjustment, by the software, of a bar to a different day. The Examiner (Office Action
dated August 23, 2006, page 4, lines 16-17) asserts that "displaying graphically relative
positioning of the selected set of parameters" as recited by claim 42 is taught by Tuli et al. at col.
7, lines 30-48. However, Appellant respectfully submits that re-positioning the bar of Tuli et al.
had no relevance with the formula of MIB Objects/Meters shown in the formula 1202's scroll
box 1203 of Manghirmalani et al., and thus the Examiner's assertion would have made no sense
technically.

The Examiner further asserts (Office Action dated August 23, 2006, page 4, lines 18-21),
"It would have been obvious to an artisan at the time of the invention to include Tuli's with
method of Manghirmalani in order to provide users with a graphical representation of priority."
However, Manghirmalani et al. had no mention of any priority, and there was no need for any
graphical representation of priority for Manghirmalani et al.'s apparatus that provided a user
with an indication of a computer network's health. The Examiner fails to explain how such a
"graphical representation of priority" would have been desirable to one skilled in the art, or how
it could have or would have been achieved, with regard to Manghirmalani et al. The Patent
Office must give specific reasons why one of ordinary skill in the art would have been motivated
to combine the references. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317
(Fed. Cir. 2000); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).
Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead,
there must be some articulated reasoning with some rational underpinning to support the legal
conclusion of obviousness. KSR Int'l v. Teleflex, Inc., supra (citing In re Kahn, supra). No such
reasons have been provided by the Examiner for the present application.

Generally, obviousness rejections may require some evidence in the prior art of a teaching, motivation, or suggestion to combine and modify the prior art references. *See, e.g., McGinley v. Franklin Sports, Inc., supra; Brown & Williamson Tobacco Corp. v. Philip Morris Inc., supra; In re Dembiczak, supra.* Here, there is no teaching, motivation, or suggestion to combine and modify the either *Manghirmalani et al.* or *Tuli et al.* as urged by the Examiner, nor does the Examiner assert that such a motivation exists in the references.

Moreover, adding a priority representation to *Manghirmalani et al.*'s system would have made no sense technically, and would have rendered *Manghirmalani et al.* unsatisfactory for its intended purpose, namely to provide a user with a simple indication of a computer network's health. The dials and graphs of *Manghirmalani et al.* were unsuitable for any modification of any "graphical representation of priority," as urged by the Examiner. If a proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP § 2143.01

Furthermore, such an addition would only add to the complexity of *Manghirmalani et al.*'s system without adding any benefit. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983). A prior art reference must be considered in this entirety including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.,* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Additionally, an example embodiment of the present application (per Abstract) is directed to selecting and placing data parameters on a data canvas, such that a user can paint a data picture representing his/her subjective motivations, mental impressions, reasons, etc., for engaging in a particular transaction. However, as discussed previously, *Manghirmalani et al.* is directed to providing a user with a simple indication of a computer network's health, and thus, *Manghirmalani et al.* is not analogous prior art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's

endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); see also *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."). The system of *Manghirmalani et al.* which was directed to providing a user with a simple indication of a computer network's health would not have commended itself to an inventor's attention in consideration of problems solved by the present application. Thus, the rejection of independent claim 42 must be reversed.

b. Dependent claim 43 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Moreover, dependent claim 43, which depends from claim 42, recites "wherein said selected set of data parameters can be selected and physically moved by such user to a gradient on said data canvas by physically manipulating an electronic pointing device." The Examiner (Office Action dated August 23, 2006, p. 4, line 21 – p. 5, line 2) contends that this feature is taught by *Tuli et al.* at col. 4, lines 62-68. As best understood, the Examiner equates the "data parameters" recited by claims 42 and 43 with the formula shown in the scroll box 1203 and the MIB Objects shown in the scroll box 1205 of *Manghirmalani et al.*'s system. However, the Examiner gives no explanation of how such MIB Objects included in a formula can be "selected and physically moved" by a user to a gradient "by physically manipulating an electronic pointing device," but instead apparently relies only on the spreadsheet and bars of *Tuli et al.*, with no regard to the system of *Manghirmalani et al.* Unless the patent otherwise provides, a claim term cannot be given a different meaning in the various claims of the same patent. *Georgia Pacific Corp. v. U.S. Gypsum Co., supra*; see also *Southwall Tech., Inc. v. Cardinal IG Co., supra*; *Fonar Corp. v. Johnson & Johnson, supra*.

The Examiner further fails to explain how entering numbers in the spreadsheet cells of *Tuli et al.*, with a resulting change in the bars (apparently accomplished by software), meets "wherein said <u>selected set of data parameters can be selected and physically moved by such user to a gradient</u> on said data canvas by physically manipulating an electronic pointing device" as

APPEAL BRIEF
Serial Number: 09/945,099
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 20
Dkt: 0006-003004

recited by claim 43. The Patent Office must give specific reasons why one of ordinary skill in the art would have been motivated to combine the references. See, e.g., *In re Kotzab, supra; In re Rouffet, supra.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l v. Teleflex, Inc., supra* (citing *In re Kahn, supra*). No such reasons have been provided by the Examiner for the present application.

Well-settled case law holds that the words of a claim must be read as they would be interpreted by those of ordinary skill in the art. *In re Baker Hughes Inc., supra; In re Morris, supra;* M.P.E.P. 2111.01. "Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach." *In re Cortright, supra.* Appellant respectfully submits that one of ordinary skill in the art of data processing would understand that "wherein said <u>selected set of data parameters can be selected and physically moved by such user to a gradient</u> on said data canvas by physically manipulating an electronic pointing device" as recited by claim 43 was not met by entering numbers in spreadsheet cells to cause software to change positions of bars in a separate graph.

Thus, the rejection of claim 43 must be reversed.

c. Dependent claim 44 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Moreover, dependent claim 44, which depends from claim 42, recites "wherein the data picture is generated using a single data capture screen including said data palette and said data canvas." The Examiner (Office Action dated August 23, 2006, p. 5, lines 3-5) contends that this feature is taught by *Manghirmalani et al.* at FIG. 13, 1307-1320. However, this cited portion of *Manghirmalani et al.* illustrates icons for selecting a particular type of display, dial meters showing a health, load, and error of the system, and a light bulb icon for selecting a net doctor display. As best understood, the Examiner has previously equated the "data parameters" recited by claims 42 and 43 with the formula shown in the scroll box 1203 and the MIB Objects shown in the scroll box 1205 of *Manghirmalani et al.*'s system. Thus, by the Examiner's interpretation, and as best understood, the "data palette" and "data canvas" have been equated by the Examiner

to structures shown in FIG. 12, which are not shown in FIG. 13. However, FIG. 13 did not show the textual representation of the MIB objects, which the Examiner's interpretation has equated to the recited "data parameters," and this interpretation is thus inconsistent with the Examiner's previous interpretation of the features of independent claim 42. Unless the patent otherwise provides, a claim term cannot be given a different meaning in the various claims of the same patent. *Georgia Pacific Corp. v. U.S. Gypsum Co., supra*; see also *Southwall Tech., Inc. v. Cardinal IG Co., supra* (holding that claim term found in different claims must be interpreted consistently); *Fonar Corp. v. Johnson & Johnson, supra* (holding that a term used in one claim had the same meaning in another claim).

Thus, the rejection of claim 44 must be reversed.

2. Independent claim 91 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Independent claim 91 recites:

> "A computer program product comprising:
> a signal bearing medium bearing at least one of
>> one or more instructions for providing a data palette, said
> palette including a set of data parameters available for selection by
> a user, such that said set of data parameters includes at least some
> corresponding to predefined statements concerning an action
> and/or a transaction; and
>> one or more instructions for providing a data canvas on
> which selected data parameters can be displayed and relatively
> positioned arbitrarily by said user to generate a data picture
>> wherein the data picture can be based at least in part on a
> graphical relative positioning of a selected group of said
> predefined statements collected from said user and pertaining to
> the user's mental impressions concerning said action and/or said
> transaction, said graphical relative positioning being configured by
> the user within the data canvas based on physical positions selected
> by the user within the data canvas for said predefined statements
> and/or a relative spatial relationship between said predefined
> statements within the data canvas concerning said action and/or
> said transaction."

The Examiner (Office Action dated August 23, 2006, page 6, line 6 – page 7, line 5) contends that these features are taught by a combination of *Manghirmalani et al.* at FIG. 12, col.

12, lines 15-46, and *Tuli et al.* at col. 7, lines 30-48. Thus, as best understood, the Examiner equates the recited "data parameters" with the MIB Objects/Meters 1204 shown in the scroll box 1205 of FIG. 12 of *Manghirmalani et al.* However, these portions of *Manghirmalani et al.* merely refer to the MIB objects, wherein the user may view a list of MIB objects, and may remove an MIB object by clicking on the object in the scroll box 1205 (col. 12, lines 23-26). However, Appellant respectfully submits that there was no mention nor suggestion by *Manghirmalani et al.* of selecting and relatively positioning arbitrarily, any of the MIB objects, by a user, or a graphical relative positioning of the MIB objects being configured by the user within the data canvas based on physical positions selected by the user within the data canvas for said predefined statements and/or a relative spatial relationship between said predefined statements within the data canvas concerning said action and/or said transaction, and thus there was no disclosure or suggestion of "one or more instructions for providing a data canvas on which selected data parameters can be displayed and relatively positioned arbitrarily by said user to generate a data picture" and "wherein the data picture can be based at least in part on a graphical relative positioning of a selected group of said predefined statements collected from said user and pertaining to the user's mental impressions concerning said action and/or said transaction, said graphical relative positioning being configured by the user within the data canvas based on physical positions selected by the user within the data canvas for said predefined statements and/or a relative spatial relationship between said predefined statements within the data canvas concerning said action and/or said transaction" as recited by independent claim 91.

The Examiner (Office Action dated August 23, 2006, page 6, line 21 – page 7, line 5) correctly acknowledges that "Manghirmalani fails to teach displaying graphically relative positioning of the selected set of parameters," and relies on *Tuli et al.* to compensate for the deficiencies of *Manghirmalani et al.*, stating:

> Tuli teaches graphically relative positioning of the selected set of data parameters. (column 7, lines 30-48)
> It would have been obvious to an artisan at the time of the invention to include Tuli's with method of Manghirmalani in order to provide users with a graphical representation of priority.

Tuli et al. (per Summary) is directed to a workflow system wherein data input by a user into a spreadsheet is computer generated into a bar chart. The system makes available to a user a graphical display of a priority time management system. There are two windows available to a user. The first window, referred to as the "spreadsheet window," is primarily used for inputting data. The second window, referred to as the "bar chart window," is primarily an output window. The output is determined by the criteria of the "spreadsheet window." The "spreadsheet window" contains a spreadsheet which is divided into multiple rows and columns. The first five columns are labeled as follows: "To-do" item, Priority, Time, Continuous, Deadline. A user inputs into the cells of each column the required data.

The "bar chart" window contains a bar graph. The bar graph consists of a y-axis and an x-axis. The "To-do" items are listed vertically along the y-axis, and the x-axis is time. The x-axis is divided into blocks representing days; each block is further divided into equal segments representing the hours of a typical work day. The bars are plotted according to the variables Priority, Time, and Deadline from the spreadsheet. The bars indicate when a user is to begin and to finish the corresponding task. Tasks which are "discontinuous" are divided into various segments of time, and spread over the days leading up to the deadline. The bars are color coded such that each "To-do" item has a distinct color based upon its priority.

However, the portion of _Tuli et al._ cited by the Examiner (col 7, lines 30-48) refers to a user adjusting priorities of tasks to be completed by different times. The user of the system of _Tuli et al._ adjusts priorities of the tasks by changing values of priorities shown in cells of spreadsheet 24 (FIG. 5c of _Tuli et al._), and a bar graph 30b is regenerated to reflect the changed values of the spreadsheet cells (FIG. 5d of _Tuli et al._).

The Examiner (Office Action dated August 23, 2006, page 7, lines 1-2) asserts that "displaying graphically relative positioning of the selected set of parameters" as recited by claim 106 is taught by _Tuli et al._ at col. 7, lines 30-48. However, Appellant respectfully submits that re-positioning the bar of _Tuli et al._ had no relevance with the formula of MIB Objects/Meters shown in the formula 1202's scroll box 1203 of _Manghirmalani et al._, and thus the Examiner's assertion would have made no sense technically.

The Examiner further asserts (Office Action dated August 23, 2006, page 7, lines 3-5), "It would have been obvious to an artisan at the time of the invention to include Tuli's with method

of Manghirmalani in order to provide users with a graphical representation of priority."

However, *Manghirmalani et al.* had no mention of any priority, and there was no need for any

graphical representation of priority for *Manghirmalani et al.*'s apparatus that provided a user

with an indication of a computer network's health. The Examiner fails to explain how such a

"graphical representation of priority" would have been desirable to one skilled in the art, or how

it could have or would have been achieved, with regard to *Manghirmalani et al.* The Patent

Office must give specific reasons why one of ordinary skill in the art would have been motivated

to combine the references. *See, e.g., In re Kotzab, supra; In re Rouffet, supra.* Rejections on

obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be

some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness. *KSR Int'l v. Teleflex, Inc., supra* (citing *In re Kahn, supra*). No such reasons have

been provided by the Examiner for the present application.

Generally, obviousness rejections may require some evidence in the prior art of a

teaching, motivation, or suggestion to combine and modify the prior art references. *See, e.g.,*

McGinley v. Franklin Sports, Inc., supra; Brown & Williamson Tobacco Corp. v. Philip Morris

Inc., supra; In re Dembiczak, supra. Here, there was no teaching, motivation, or suggestion to

combine and modify the either *Manghirmalani et al.* or *Tuli et al.* as urged by the Examiner, nor

does the Examiner assert that such a motivation existed in the references.

Moreover, adding a priority representation to *Manghirmalani et al.*'s system would have

made no sense technically, and would have rendered *Manghirmalani et al.* unsatisfactory for its

intended purpose, namely to provide a user with a simple indication of a computer network's

health. The dials and graphs of *Manghirmalani et al.* were unsuitable for any modification of

any "graphical representation of priority," as urged by the Examiner. If a proposed modification

would render the prior art being modified unsatisfactory for its intended purpose, then there is no

suggestion or motivation to make the proposed modification. *In re Gordon, supra.* Further, if

the proposed modification or combination of the prior art would change the principle of

operation of the prior art invention being modified, then the teachings of the references are not

sufficient to render the claims *prima facie* obvious. *In re Ratti, supra.* MPEP § 2143.01

Furthermore, such an addition would only have added to the complexity of

Manghirmalani et al.'s system without adding any benefit. It is improper to combine references

where the references teach away from their combination. *In re Grasselli, supra.* A prior art reference must be considered in this entirety including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc., supra.*

Additionally, an example embodiment of the present application (per Abstract) is directed to selecting and placing data parameters on a data canvas, such that a user can paint a data picture representing his/her subjective motivations, mental impressions, reasons, etc., for engaging in a particular transaction. However, *Manghirmalani et al.* was directed to providing a user with a simple indication of a computer network's health, and thus, *Manghirmalani et al.* was not analogous prior art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker, supra*; see also *In re Clay, supra* ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.").

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne,* 1 *supra*; *In re Deuel, supra*; *In re Bell, supra*; *In re Oetiker, supra.* In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra*; *In re Lunsford, supra*; *In re Freed, supra.* Appellant respectfully submits that the Examiner has not met this burden with respect to at least independent claim 91.

Thus, the rejection of independent claim 91 must be reversed.

3. Independent claim 99 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Independent claim 99 recites:

> "A method of permitting a user to input a data picture
> expressing mental impressions concerning an action and/or
> transaction, the method comprising:
> providing a set of a plurality of individual assertions, said
> assertions being associated with such mental impressions; and

> displaying said set of assertions to the user in a first portion of a visible electronic interface; and
>
> permitting the user to select and move personalized individual assertions taken from said sets of assertions to a second, separate portion of said visible interface, which second separate portion acts as a data canvas for displaying such personalized individual assertions; and
>
> wherein said personalized individual assertions can be relatively positioned by the user relative to one another within the data canvas to create the data picture."

The Examiner (Office Action dated August 23, 2006, page 7, line 21) states, "As per claim 99, it rejected with the same rationale as claim 91. (see rejection above)"

However, Appellant respectfully submits that independent claim 99 recites features not recited by claim 91. For example, independent claim 99 recites, "permitting the user to select and move personalized individual assertions taken from said sets of assertions to a second, separate portion of said visible interface, which second separate portion acts as a data canvas for displaying such personalized individual assertions; and wherein said personalized individual assertions can be relatively positioned by the user relative to one another within the data canvas to create the data picture," which is not recited by independent claim 91. The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne, supra*; *In re Deuel, supra*; *In re Bell, supra*; *In re Oetiker, supra*. In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra*; *In re Lunsford, supra*; *In re Freed, supra*. Appellant respectfully submits that the Examiner has not met this burden with respect to at least independent claim 99.

Furthermore, the Administrative Procedures Act (APA) mandates the Patent Office to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the reasoning in reaching its conclusions. See *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Gartside*, 203 F.3d 1305, 1314, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000). The Examiner has failed to provide any findings with regard to the rejection of independent claim 99. Moreover, Appellant respectfully submits that the features recited by claim 99 are neither disclosed nor suggested by

any of the cited references, neither alone nor in any reasonable combination, and thus, the rejection of claim 99 must be reversed.

4. Independent claim 106 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Independent claim 106 recites:

> "A method of capturing data concerning an actual or proposed transaction from the user of a computing system, said system including at least a keyboard and pointing device for inputting data, the method comprising:
> providing a set of a plurality of individual assertions, said assertions being associated with mental impressions of the user relating to the transaction; and
> displaying said sets of assertions to the user in a first portion of a visible electronic interface; and
> permitting the user to select and move the selected assertions taken from said set of assertions to a second, separate portion of said visible interface, which second separate portion acts to display such selected assertions along a visible gradient; and
> permitting the user to relatively position said selected assertions in a ranking order relative to each other along said visible gradient to create a data picture."

The Examiner (Office Action dated August 23, 2006, page 8, lines 14-19) contends that "displaying said sets of assertions to the user in a first portion of a visible electronic interface" as recited by claim 106 is taught by *Manghirmalani et al.* at col. 12, lines 1-47, and that "permitting the user to select and move selected assertions taken from said set of assertions to a second, separate portion of said visible interface, which second separate portion acts to display such selected assertions along a visible gradient" is taught by *Manghirmalani et al.* at col. 12, lines 16-20. However, these portions of *Manghirmalani et al.* merely refer to the MIB objects discussed previously, wherein the user may view a list of MIB objects, and may remove an MIB object by clicking on the object in the scroll box 1205 (col. 12, lines 23-26). Appellant respectfully submits that there was no mention nor suggestion by *Manghirmalani et al.* of selecting and moving any of the MIB objects, by a user, to a second, separate portion of an interface, and thus there was no disclosure or suggestion of "displaying said sets of assertions to the user in a first portion of a visible electronic interface" and "permitting the user to select and

APPEAL BRIEF
Serial Number: 09/945,099
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 28
Dkt: 0006-003004

move selected assertions taken from said set of assertions to a second, separate portion of said visible interface, which second separate portion acts to display such selected assertions along a visible gradient" as recited by claim 106.

The Examiner (Office Action dated August 23, 2006, page 9, lines 1-2) correctly acknowledges that "Manghirmalani fails to teach displaying graphically relative positioning of the selected set of parameters," and relies on *Tuli et al.* to compensate for the deficiencies of *Manghirmalani et al.*

Tuli et al. (per Summary) is directed to a workflow system wherein data input by a user into a spreadsheet is computer generated into a bar chart. The system makes available to a user a graphical display of a priority time management system. There are two windows available to a user. The first window, referred to as the "spreadsheet window," is primarily used for inputting data. The second window, referred to as the "bar chart window," is primarily an output window. The output is determined by the criteria of the "spreadsheet window." The "spreadsheet window" contains a spreadsheet which is divided into multiple rows and columns. The first five columns are labeled as follows: "To-do" item, Priority, Time, Continuous, Deadline. A user inputs into the cells of each column the required data.

The "bar chart" window contains a bar graph. The bar graph consists of a y-axis and an x-axis. The "To-do" items are listed vertically along the y-axis, and the x-axis is time. The x-axis is divided into blocks representing days; each block is further divided into equal segments representing the hours of a typical work day. The bars are plotted according to the variables Priority, Time, and Deadline from the spreadsheet. The bars indicate when a user is to begin and to finish the corresponding task. Tasks which are "discontinuous" are divided into various segments of time, and spread over the days leading up to the deadline. The bars are color coded such that each "To-do" item has a distinct color based upon its priority.

Tuli et al., at col 7, lines 30-48, discusses a user adjusting a priority of a task in the spreadsheet window, which results in a regeneration of the bar graph in the bar chart window, with an adjustment, by the software, of a bar to a different day. The Examiner (Office Action dated August 23, 2006, page 9, lines 3-4) asserts that "displaying graphically relative positioning of the selected set of parameters" as recited by claim 106 is taught by *Tuli et al.* at col. 7, lines 30-48. However, Appellant respectfully submits that re-positioning the bar of *Tuli et al.* has no

relevance with the formula of MIB Objects/Meters shown in the formula 1202's scroll box 1203

of *Manghirmalani et al.*, and thus the Examiner's assertion made no sense technically.

The Examiner further asserts (Office Action dated August 23, 2006, page 9, lines 5-7), "It

would have been obvious to an artisan at the time of the invention to include Tuli's with method

of Manghirmalani in order to provide users with a graphical representation of priority."

However, *Manghirmalani et al.* has no mention of any priority, and there is no need for any

graphical representation of priority for *Manghirmalani et al.*'s apparatus that provides a user

with an indication of a computer network's health. The Examiner fails to explain how such a

"graphical representation of priority" would have been desirable to one skilled in the art, or how

it could have or would have been achieved, with regard to *Manghirmalani et al.* The Patent

Office must give specific reasons why one of ordinary skill in the art would have been motivated

to combine the references. *See, e.g., In re Kotzab, supra; In re Rouffet, supra.* Rejections on

obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be

some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness. *KSR Int'l v. Teleflex, Inc., supra* (citing *In re Kahn, supra*). No such reasons have

been provided by the Examiner for the present application.

Generally, obviousness rejections may require some evidence in the prior art of a

teaching, motivation, or suggestion to combine and modify the prior art references. *See, e.g.,*

McGinley v. Franklin Sports, Inc., supra; Brown & Williamson Tobacco Corp. v. Philip Morris

Inc., supra; In re Dembiczak, supra. Here, there is no teaching, motivation, or suggestion to

combine and modify the either *Manghirmalani et al.* or *Tuli et al.* as urged by the Examiner, nor

does the Examiner assert that such a motivation exists in the references.

Moreover, adding a priority representation to *Manghirmalani et al.*'s system would have

made no sense technically, and would have rendered *Manghirmalani et al.* unsatisfactory for its

intended purpose, namely to provide a user with a simple indication of a computer network's

health. The dials and graphs of *Manghirmalani et al.* were unsuitable for any modification of

any "graphical representation of priority," as urged by the Examiner. If a proposed modification

would render the prior art being modified unsatisfactory for its intended purpose, then there was

no suggestion or motivation to make the proposed modification. *In re Gordon, supra.* Further, if

the proposed modification or combination of the prior art would change the principle of

operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti, supra*. MPEP § 2143.01

Furthermore, such an addition would only have added to the complexity of *Manghirmalani et al.*'s system without adding any benefit. It is improper to combine references where the references teach away from their combination. *In re Grasselli, supra*. A prior art reference must be considered in this entirety including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc., supra.*

Additionally, an example embodiment of the present application (per Abstract) is directed to selecting and placing data parameters on a data canvas, such that a user can paint a data picture representing his/her subjective motivations, mental impressions, reasons, etc., for engaging in a particular transaction. However, as discussed previously, *Manghirmalani et al.* is directed to providing a user with a simple indication of a computer network's health, and thus, *Manghirmalani et al.* was not analogous prior art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker, supra*; see also *In re Clay, supra* ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.").

The Examiner (Office Action dated August 23, 2006, page 8, lines 18-19) further states (*emphasis added*), "It is inherent that the same MIB objects *can be used* in different formula." Appellant respectfully submits that, even if it were permissible, multi-use of the MIB objects in formulas of *Manghirmalani et al.* would not have taught "displaying said sets of assertions to the user in a first portion of a visible electronic interface" and "permitting the user to select and move selected assertions taken from said set of assertions to a second, separate portion of said visible interface, which second separate portion acts to display such selected assertions along a visible gradient" as recited by claim 106. However, with regard to rejections under 35 U.S.C. § 102, Appellant further respectfully submits that inherency requires that the missing descriptive material is "necessarily present," not merely probably or possibly present, in the prior art. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citing *Continental*

Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). Similarly, with regard to obviousness rejections, conjecture on the part of the Examiner that the MIB objects of *Manghirmalani et al.* "can be used" in different formulas fails to further the Examiner's attempts to justify the rejection of claim 106.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne, supra; In re Deuel, supra; In re Bell, supra; In re Oetiker, supra.* In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra; In re Lunsford, supra; In re Freed, supra.* Appellant respectfully submits that the Examiner has not met this burden with respect to at least independent claim 106.

Thus, the rejection of independent claim 106 must be reversed.

5. Independent claim 111 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Independent claim 111 recites:

> "A method of generating program data from user input data concerning an actual or proposed action and/or transaction, the method comprising:
>> providing the user with a palette of individual assertions associated with the user's perceptions of such action and/or transaction in a first portion of a visible interface; and
>> permitting the user to select and move selected assertions taken from said set of assertions to a second, separate portion of said visible interface, which second separate portion acts to visibly display such selected assertions;
>> permitting the user to relatively position said selected assertions in a ranking order relative to each other so as to constitute the user input data; and
>> converting the user input data into program data, by assigning numerical values to such program data corresponding to said relative positioning of said selected assertions."

The Examiner (Office Action dated August 23, 2006, page 9, line 17) states, "As per claim 111, it is rejected with the same rationale as claim 106. (see rejection above)"

However, Appellant respectfully submits that independent claim 111 recites features not explicitly recited by claim 106. For example, independent claim 111 recites, "permitting the user

to relatively position said selected assertions in a ranking order relative to each other so as to constitute the user input data; and converting the user input data into program data, by assigning numerical values to such program data corresponding to said relative positioning of said selected assertions," which is not explicitly recited by independent claim 106. The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne, supra*; *In re Deuel, supra*; *In re Bell, supra*; *In re Oetiker, supra*. In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra*; *In re Lunsford, supra*; *In re Freed, supra*. Appellant respectfully submits that the Examiner has not met this burden with respect to at least independent claim 111.

Moreover, Appellant asserts that the reasoning that the Examiner puts forth for the rejection with respect to claim 111 contravenes 35 U.S.C. § 132, which requires the Director to "notify the applicant thereof, stating the reasons for such rejection." This section is violated if the rejection "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." *Chester v. Miller*, 906 F.2d 1574, 15 USPQ2d 1333 (Fed. Cir. 1990). This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity." Furthermore, MPEP § 706.02(j) indicates that: "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply."

Furthermore, the Administrative Procedures Act (APA) mandates the Patent Office to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the reasoning in reaching its conclusions. See *In re Zurko, supra*; *In re Gartside, supra*. The Examiner has failed to provide any findings with regard to the rejection of independent claim 111. Moreover, Appellant respectfully submits that the features recited by claim 111 are neither disclosed nor suggested by any of the cited references, neither alone nor in any reasonable combination, and thus, the rejection of claim 111 must be reversed.

APPEAL BRIEF
Serial Number: 09/945,099
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 33
Dkt: 0006-003004

6. Independent claim 121 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Further, independent claim 121 recites:

"A method of capturing input data from a user within an electronic interface comprising:

(a) providing a menu within the interface for presenting a set of data parameters to the user;

(b) providing a canvas in association with the interface for creating a data record based on said set of data parameters;

(c) moving a selected data parameter from the set of data parameters to said canvas; and

(d) relatively positioning said selected data parameter on said canvas so as to indicate a corresponding weighting factor to be associated with said selected data parameter."

The Examiner (Office Action dated August 23, 2006, page 11, lines 3-8) contends that "(a) providing a menu within the interface for presenting a set of data parameters to the user" is taught by FIG. 12, item 1204 of *Manghirmalani et al.*, and that "(c) moving a selected data parameter from the set of data parameters to said canvas" is taught by FIG. 12, items 1208-1213. However, nowhere does *Manghirmalani et al.* suggest or disclose any kind of movement of any of the MIB Objects/Meters 1204 from the scroll box 1205 to any of items 1208-1213 of FIG. 12, and no reasonable combination of *Manghirmalani et al.* and *Tuli et al.* cures this deficiency.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne, supra*; *In re Deuel, supra*; *In re Bell, supra*; *In re Oetiker, supra*. In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra*; *In re Lunsford, supra*; *In re Freed, supra*. Appellant respectfully submits that the Examiner has not met this burden with respect to at least independent claim 121.

Moreover, Appellant respectfully submits that the features recited by claim 121 are neither disclosed nor suggested by any of the cited references, neither alone nor in any reasonable combination, and thus, the rejection of claim 121 must be reversed.

APPEAL BRIEF
Serial Number: 09/945,099
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 34
Dkt: 0006-003004

7. Independent claim 126 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Independent claim 126 recites:

"A method of providing feedback to a user during a data input session comprising:

(a) collecting input data from the user using a data interface, said input data comprising:

i) one or more selected data parameters;

ii) weighting information identifying a corresponding weighting factor to be given to each of said one or more selected data parameters; and

(b) providing feedback information to the user while the user is providing said input data, said feedback information being based at least in part on said input data such that the user can monitor the effect of changing said one or more selected data parameters and/or their associated weighting factors based on relative positioning of each of the selected data parameters by the user."

The Examiner (Office Action dated August 23, 2006, page 12, line 8) states, "As per claim 126, it is rejected with the same rationale as claim 106. (see rejection above)"

However, Appellant respectfully submits that independent claim 126 recites features not explicitly recited by claim 106. For example, independent claim 126 recites, "ii) weighting information identifying a corresponding weighting factor to be given to each of said one or more selected data parameters; and (b) providing feedback information to the user while the user is providing said input data, said feedback information being based at least in part on said input data such that the user can monitor the effect of changing said one or more selected data parameters and/or their associated weighting factors based on relative positioning of each of the selected data parameters by the user," which is not explicitly recited by independent claim 106. The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne, supra; In re Deuel, supra; In re Bell, supra; In re Oetiker, supra.* In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra; In re Lunsford, supra; In re Freed, supra.* Appellant respectfully submits that the Examiner has not met this burden with respect to at least independent claim 126.

Moreover, Appellant asserts that the reasoning that the Examiner puts forth for the rejection with respect to claim 126 contravenes 35 U.S.C. § 132, which requires the Director to "notify the applicant thereof, stating the reasons for such rejection." This section is violated if the rejection "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." *Chester v. Miller, supra.* This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity." Furthermore, MPEP § 706.02(j) indicates that: "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply."

Furthermore, the Administrative Procedures Act (APA) mandates the Patent Office to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the reasoning in reaching its conclusions. See *In re Zurko, supra; In re Gartside, supra.* The Examiner has failed to provide any findings with regard to the rejection of independent claim 126. Moreover, Appellant respectfully submits that the features recited by claim 126 are neither disclosed nor suggested by any of the cited references, neither alone nor in any reasonable combination, and thus, the rejection of claim 126 must be reversed.

8. Independent claim 131 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Independent claim 131 recites:

> "A method of evaluating data records associated with an action and/or transaction, the method comprising:
> (a) storing one or more data records, each of said data records including:
>   i)   a set of data parameters identified by a user as pertaining to the action and/or transaction;
>   ii)   a weighting factor to be given to each data parameters in said set of data parameters based on a relative positioning of each of the data parameters by the user;
> (b) processing a query by the user, said query requesting an evaluation of a frequency of usage for a data parameter, and/or an

> evaluation of a rating given to a weighting factor associated with said data parameter, across said data records or a subset thereof; and
>
>   (c) providing feedback to the user in response to said query."

The Examiner (Office Action dated August 23, 2006, page 13, line 3) states, "As per claim 131, it is rejected with the same rationale as claim 106. (see rejection above)"

However, Appellant respectfully submits that independent claim 131 recites features not explicitly recited by claim 106. For example, independent claim 131 recites, "ii) a weighting factor to be given to each data parameters in said set of data parameters based on a relative positioning of each of the data parameters by the user; (b) processing a query by the user, said query requesting an evaluation of a frequency of usage for a data parameter, and/or an evaluation of a rating given to a weighting factor associated with said data parameter, across said data records or a subset thereof; and (c) providing feedback to the user in response to said query," which is not explicitly recited by independent claim 106. The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne, supra*; *In re Deuel, supra*; *In re Bell, supra*; *In re Oetiker, supra*. In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra*; *In re Lunsford, supra*; *In re Freed, supra*. Appellant respectfully submits that the Examiner has not met this burden with respect to at least independent claim 131.

Moreover, Appellant asserts that the reasoning that the Examiner puts forth for the rejection with respect to claim 131 contravenes 35 U.S.C. § 132, which requires the Director to "notify the applicant thereof, stating the reasons for such rejection." This section is violated if the rejection "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." *Chester v. Miller, supra*. This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity." Furthermore, MPEP § 706.02(j) indicates that: "[i]t is important for an

examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply."

Furthermore, the Administrative Procedures Act (APA) mandates the Patent Office to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the reasoning in reaching its conclusions. See *In re Zurko*, *supra*; *In re Gartside*, *supra*. The Examiner has failed to provide any findings with regard to the rejection of independent claim 131. Moreover, Appellant respectfully submits that the features recited by claim 131 are neither disclosed nor suggested by any of the cited references, neither alone nor in any reasonable combination, and thus, the rejection of claim 131 must be reversed.

9. Independent claim 136 is not rendered obvious by *Manghirmalani et al.* in view of *Tuli et al.*

Independent claim 136 recites:

"A method of creating a data record based on input data from a user provided with an interface, the method comprising:
(a) generating a first data picture at a first time within the interface, said first data picture including a first set of data parameters and associated weighting factors,
wherein said first data picture is created before the user performs an action and/or transaction associated with said first set of data parameters;
(b) generating a second data picture at a second time within the interface, said second data picture including a second set of data parameters and associated weighting factors based on a relative positioning of each of the second set of data parameters by the user,
wherein said second data picture is created after the user performs said action and/or said transaction; and
(c) modifying said second data picture at a third time within the interface using said second set of data parameters,
wherein both said first data picture and said second picture are used to create a data record."

The Examiner (Office Action dated August 23, 2006, page 13, line 13) states, "As per claim 136, it is rejected with the same rationale as claim 106. (see rejection above)"

However, Appellant respectfully submits that independent claim 136 recites features not explicitly recited by claim 106. For example, independent claim 136 recites, "wherein said first data picture is created before the user performs an action and/or transaction associated with said first set of data parameters; (b) generating a second data picture at a second time within the interface, said second data picture including a second set of data parameters and associated weighting factors based on a relative positioning of each of the second set of data parameters by the user, wherein said second data picture is created after the user performs said action and/or said transaction; and (c) modifying said second data picture at a third time within the interface using said second set of data parameters, wherein both said first data picture and said second picture are used to create a data record," which is not explicitly recited by independent claim 106. The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne, supra; In re Deuel, supra; In re Bell, supra; In re Oetiker, supra.* In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra; In re Lunsford, supra; In re Freed, supra.* Appellant respectfully submits that the Examiner has not met this burden with respect to at least independent claim 136.

Moreover, Appellant asserts that the reasoning that the Examiner puts forth for the rejection with respect to claim 136 contravenes 35 U.S.C. § 132, which requires the Director to "notify the applicant thereof, stating the reasons for such rejection." This section is violated if the rejection "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." *Chester v. Miller, supra.* This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity." Furthermore, MPEP § 706.02(j) indicates that: "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply."

Furthermore, the Administrative Procedures Act (APA) mandates the Patent Office to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the reasoning in reaching its conclusions. See *In*

re Zurko, _supra_; _In re Gartside_, _supra_. The Examiner has failed to provide any findings with regard to the rejection of independent claim 136. Moreover, Appellant respectfully submits that the features recited by claim 136 are neither disclosed nor suggested by any of the cited references, neither alone nor in any reasonable combination, and thus, the rejection of claim 136 must be reversed.

10. Dependent claims 48-52, 92-94, 98, 100-101, 105, 107-108, 110, 113-120, 122-123, 127, 129, 132-134, and 140 are not rendered obvious by _Manghirmalani et al._ in view of _Tuli et al._

Appellant respectfully submits that the deficiencies discussed previously with regard to _Manghirmalani et al._ with regard to independent claim 42 are not cured by the addition of _Tuli et al._ By virtue of their dependency on allowable independent claim 42, dependent claims 48-52 are allowable for at least the same reasons as claim 42, and are separately patentable on their own merits. Appellant further submits that dependent claim 48 depends from claim 47, which is rejected based on _Manghirmalani et al._ and _Tuli et al._ in view of _Ferguson et al._, as discussed below. However, claim 48 is rejected based on _Manghirmalani et al._ in view of _Tuli et al._ (Office Action dated August 23, 2006, page 5, lines 9 –11), relying on the rejection of claim 47. Such a rejection is at best confusing and uninformative. Moreover, Appellant asserts that the reasoning that the Examiner puts forth for the rejection with respect to claim 48 contravenes 35 U.S.C. § 132, which requires the Director to "notify the applicant thereof, stating the reasons for such rejection." This section is violated if the rejection "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." _Chester v. Miller_, _supra_. This policy is captured in the Manual of Patent Examining Procedure. For example, MPEP § 706 states that "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity." Furthermore, MPEP § 706.02(j) indicates that: "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." Thus, the rejection of claim 48 must be reversed.

Appellant respectfully submits that the deficiencies discussed previously with regard to _Manghirmalani et al._ and _Tuli et al._ with regard to independent claims 91, 99, 106, 111, 121,

126, 131, and 141 also apply to their respective dependent claims. Neither of *Manghirmalani et al.* nor *Tuli et al.* neither alone nor in and reasonable combination, disclose or suggest the features recited by the respective dependent claims 92-94, 98, 100-101, 105, 107-108, 110, 113-120, 122-123, 127, 129, 132-134, and 140, nor of any other pending claims as discussed previously. Thus, the rejection of dependent claims 48-52, 92-94, 98, 100-101, 105, 107-108, 110, 113-120, 122-123, 127, 129, 132-134, and 140 must be reversed.

C.   **CLAIMS 46, 47, 95-97, 102-104, 109, 112, 124, 125, 130, 135, 144, AND 145 ARE NOT RENDERED OBVIOUS BY *MANGHIRMALANI ET AL.* AND *TULI ET AL.* IN VIEW OF *FERGUSON ET AL.***

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed .Cir. 1997); *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

"Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. *See In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ([R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with

some rational underpinning to support the legal conclusion of obviousness.)." *KSR Int'l v.*

Teleflex, Inc., No. 04-1350, slip op. at 14 (U.S., April 30, 2007)

1. Dependent claim 46 is not rendered obvious by *Manghirmalani et al.* and *Tuli et al.* in view of *Ferguson et al.*

Dependent claim 46 recites:

> "The interface of claim 45, wherein said numeric data
> values are based on the physical location of said selected set of
> data parameters as placed by the user on said data canvas."

The Examiner (Office Action dated August 23, 2006, page 13, line 19 – page 14, line 6) states:

> As per claim 46, Manghinnalani and Tuli teach the interface of claim 45.
> However, they fail to teach wherein said numeric data values are based on the
> physical location of said selected set of data parameters as placed by the user on
> said data canvas.
> Ferguson et al. teaches wherein said numeric data values are based on the
> physical location of said selected set of data parameters as placed by the user on
> said data canvas. (col. 8, lines 46-64)
> It would have been obvious to an artisan at the time of the invention to
> include Ferguson's teaching with method of Manghirmalani and Tuli in order to
> provide user with the ability to see the possible results of different hypothetical
> scenarios.

Ferguson et al. is directed to provide a graphical framework to facilitate the providing of financial advice to a customer by displaying temporal for the customer (col. 1, lines 49-53). The portion of *Ferguson et al.* cited by the Examiner with regard to claim 46 refers to FIG. 6, wherein a customer may use direct manipulation to "grab" an icon off a "fence" line and position it on a "canvas" above a date on which the customer expects an event to occur. For example, the date could be the date that a child might be expected to enter college. This new position of the PEI represents an "event date," which is the date on which an event in question occurs (and for which the financial planning is being carried out). According to *Ferguson et al.*, the event date is the date on which funds will need to be expended to facilitate the life event.

Appellant respectfully submits that the graphical framework of *Ferguson et al.* had nothing to do with the system health charts of *Manghirmalani et al.*, nor the priorities of *Tuli et*

al., nor with the interface for capturing subjective preferences of program users of the present application. Thus, *Ferguson et al.* was not analogous art to the claims of the present application, nor to the other cited references with regard to the rejection of claim 46. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker, supra*; see also *In re Clay, supra* ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."). Appellant respectfully submits that the stock price charts shown in *Black et al.* graphical framework of *Ferguson et al.* had nothing to do with the features recited by claim 46. Thus, the rejection of claim 46 must be reversed.

2. Dependent claim 47 is not rendered obvious by *Manghirmalani et al.* and *Tuli et al.* in view of *Ferguson et al.*

Further, dependent claim 47, which depends from independent claim 42, recites, "wherein said selected set of data parameters, including individual ones of said selected group of predefined statements can be ranked in relative importance by the user based on their location on said data canvas." The Examiner (Office Action dated August 23, 2006, p. 14, lines 7-19) contends that this feature was taught by *Ferguson et al.* at col. 12, lines 16-54. The Examiner further comments, "Allowing user to decide how much money should be allocated into to each categories, such as stocks, bond, and cash, Ferguson effectively provide the user with the ability to rank the relative importance of each category in his/her over all financial investment strategy)." However, as discussed previously, as best understood, the Examiner equates the "data parameters" recited by claim 42 with the formula shown in the scroll box 1203 and the MIB Objects shown in the scroll box 1205 of *Manghirmalani et al.*'s system. The Examiner gives no explanation of how such MIB Objects included in a formula relating to the health of a system of *Manghirmalani et al.* could have been related to allowing a user to decide how much money should be allocated into "categories such as stocks, bonds, and cash" relating to the system of *Ferguson et al.* The Examiner merely states, "It would have been obvious to an

artisan at the time of the invention to include Ferguson's teaching with method of Manghirmalani and Tuli in order to provide user with the ability to see the possible results of different hypothetical scenarios," with no explanation of how "an artisan" would have combined the stocks and bonds information screen shown in FIG. 10, and discussed at col. 12, lines 16-54 of *Ferguson et al.* with *Manghirmalani et al.* and *Tuli et al.*

The Examiner further fails to explain how *Ferguson et al.*'s user interface for determining an asset allocation strategy among stocks, bonds, and cash would have met "wherein said selected set of data parameters, including individual ones of said selected group of predefined statements can be ranked in relative importance by the user based on their location on said data canvas" as recited by claim 47, as the Examiner has previously equated the "data parameters" with the MIB objects of *Manghirmalani et al.* Unless the patent otherwise provides, a claim term cannot be given a different meaning in the various claims of the same patent. *Georgia Pacific Corp. v. U.S. Gypsum Co., supra*; see also *Southwall Tech., Inc. v. Cardinal IG Co., supra* (holding that claim term found in different claims must be interpreted consistently); *Fonar Corp. v. Johnson & Johnson, supra* (holding that a term used in one claim had the same meaning in another claim).

The Patent Office must give specific reasons why one of ordinary skill in the art would have been motivated to combine the references. See, e.g., *In re Kotzab, supra*; *In re Rouffet, supra*. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l v. Teleflex, Inc., supra* (citing *In re Kahn, supra*) No such reasons have been provided by the Examiner for the present application.

Well-settled case law holds that the words of a claim must be read as they would be interpreted by those of ordinary skill in the art. *In re Baker Hughes Inc., supra*; *In re Morris, supra*; M.P.E.P. 2111.01. "Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach." *In re Cortright, supra*. Appellant respectfully submits that one of ordinary skill in the art of data processing would have understood that "wherein said selected set of data parameters, including individual ones of said selected group of predefined statements can be ranked in relative importance by the user based on their location on said data canvas" as recited

by claim 47 was not met by allowing a user to decide how much money should be allocated into

"categories such as stocks, bonds, and cash" relating to the system of *Ferguson et al*, as urged by

the Examiner.

Thus, the rejection of claim 47 must be reversed.

3. Dependent claims 95-97, 102-104, 109, 112, 124, 125, 130, 135, 144, and 145 are not rendered obvious by *Manghirmalani et al.* and *Tuli et al.* in view of *Ferguson et al.*

Appellant respectfully submits that the deficiencies discussed previously with regard to

Manghirmalani et al. and *Tuli et al.* with regard to independent claims 91, 99, 106, 111, 121,

126, 131, and 141 were not cured by the addition of *Ferguson et al.* None of *Manghirmalani et*

al., Tuli et al., nor *Ferguson et al.*, neither alone nor in and reasonable combination, disclose or

suggest the features recited by claims 95-97, 102-104, 109, 112, 124, 125, 130, 135, 144, and

145, nor of any other pending claims as discussed previously. Thus, the rejection of claims 95-

97, 102-104, 109, 112, 124, 125, 130, 135, 144, and 145 must be reversed.

D.   CLAIMS 138 AND 139 ARE NOT RENDERED OBVIOUS BY *MANGHIRMALANI ET AL.* AND *TULI ET AL.* IN VIEW OF *BLACK ET AL.*

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed

invention under any statutory provision always rests upon the Examiner. *In re Mayne, supra*; *In*

re Deuel, supra; *In re Bell, supra*; *In re Oetiker, supra.* In rejecting a claim under 35 U.S.C. §

103, the Examiner is required to provide a factual basis to support the obviousness conclusion.

In re Warner, supra; *In re Lunsford, supra*; *In re Freed, supra.*

To establish prima facie obviousness of a claimed invention, all the claim limitations

must be taught or suggested by the prior art. *In re Royka, supra.* "All words in a claim must be

considered in judging the patentability of that claim against the prior art." *In re Wilson, supra.*

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom

is nonobvious. *In re Fine, supra.*

"Often, it will be necessary for a court to look to interrelated teachings of multiple

patents; the effects of demands known to the design community or present in the marketplace;

and the background knowledge possessed by a person having ordinary skill in the art, all in order

to determine whether there was an apparent reason to combine the known elements in the fashion

claimed by the patent at issue. To facilitate review, this analysis should be made explicit. *See In*

re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006) ([R]ejections on obviousness grounds cannot be

sustained by mere conclusory statements; instead, there must be some articulated reasoning with

some rational underpinning to support the legal conclusion of obviousness.)." *KSR Int'l v.*

Teleflex, Inc., No. 04-1350, slip op. at 14 (U.S., April 30, 2007)

1. Dependent claim 138 is not rendered obvious by *Manghirmalani et al.* and *Tuli et al.* in view of *Black et al.*

Dependent claim 138 recites:

> "The method of claim 136, wherein said action and/or
> transaction pertains to trading a security, and said first data picture
> is associated with the purchase of said security, and said second
> data picture is associated with a sale of said security."

The Examiner (Office Action dated August 23, 2006, page 17, lines 4-13) states:

> As per claim 138, Manghirmalani and Tuli teach the method of claim 136.
> However, they fails to teaches [*sic*] the method wherein said action and/or
> transaction pertains to trading a security, and said first data picture is associated
> with a purchase of said security, and said second data picture is associated with a
> sale of said security.
> Black et al. teaches a method wherein said action and/or transaction
> pertains to trading a security, and said first data picture is associated with a
> purchase of said security, and said second data picture is associated with a sale of
> said security (col. 10, lines 16-36).
> It would have been obvious to an artisan at the time of the invention to
> include Black's teaching with method of Manghirmalani and Tuli in order to
> provide user with the ability to set up alert for financial events.

Black et al. (per Abstract) is directed to a system for securities analysis, particularly, to a

system for combining disparate time-relevant securities analyses, and to a system for variably

combining a technical price and volume analysis with a fundamental analysis for a given

security, and displaying the time-relevant results of the combination. The portion of *Black et al.*

cited by the Examiner relates to FIGs. 3 and 4 of *Black et al.*, which illustrate stock price charts

that were produced by software that analyzed stock prices over time. Appellant respectfully

submits that the stock price charts of *Black et al.* had nothing to do with the system health charts of *Manghirmalani et al.*, nor the priorities of *Tuli et al.*, nor with the interface for capturing subjective preferences of program users of the present application. Thus, *Black et al.* was not analogous art to the claims of the present application, nor to the other cited references with regard to the rejection of claim 138. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker, supra*; see also *In re Clay, supra* ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."). Appellant respectfully submits that the stock price charts shown in *Black et al.* had nothing to do with the combination of features recited by dependent claim 138.

Further, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l v. Teleflex, Inc., supra* (citing *In re Kahn, supra*). Appellant respectfully submits that, as the stock price charts shown in *Black et al.* had nothing to do with the combination of features recited by dependent claim 138, the Examiner has failed to provide any "articulated reasoning with some rational underpinning to support" a legal conclusion of obviousness. Thus, the rejection of claim 138 must be reversed.

2. Dependent claim 139 is not rendered obvious by *Manghirmalani et al.* and *Tuli et al.* in view of *Black et al.*

With regard to the rejection of dependent claim 139, the Examiner (Office Action dated August 23, 2006, page 17, lines 14-16) states:

> As per claim 139, Manghirmalani, Tuli and Black teach the method of claim 138. Black further teaches the method including a step (d): providing feedback to the user to indicate a financial performance associated with said trading of said security (col. 10, lines 16-36).

The Examiner fails to provide any motivation for such a combination. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has

done. MPEP 706.02(j) "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner completely fails in his burden to present a "convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references," at least with regard to claim 139.

Furthermore, the Administrative Procedures Act (APA) mandates the Patent Office to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the reasoning in reaching its conclusions. See *In re Zurko, supra*; *In re Gartside, supra*. Moreover, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l v. Teleflex, Inc., supra* (citing *In re Kahn, supra*). The Examiner has failed to provide any findings with regard to the rejection of dependent claim 139. Moreover, Appellant respectfully submits that the features recited by claim 139 were neither disclosed nor suggested by any of the cited references, neither alone nor in any reasonable combination, and thus, the rejection of claim 139 must be reversed.

Thus, the rejection of claims 138 and 139 must be reversed.

E.   CLAIMS 128 AND 137 ARE NOT RENDERED OBVIOUS BY ANY COMBINATION OF *MANGHIRMALANI ET AL.*, *TULI ET AL.*, *WREN*, OR *RICHARDS.*

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne, supra*; *In re Deuel, supra*; *In re Bell, supra*; *In re Oetiker, supra*. In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner, supra*; *In re Lunsford, supra*; *In re Freed, supra*.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka, supra*. "All words in a claim must be

considered in judging the patentability of that claim against the prior art." *In re Wilson, supra.* If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine, supra.*

"Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. *See In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ([R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.)." *KSR Int'l v. Teleflex, Inc.,* No. 04-1350, slip op. at 14 (U.S., April 30, 2007)

Appellant respectfully submits that the deficiencies discussed previously with regard to *Manghirmalani et al., Tuli et al., Black et al.* and *Ferguson et al.* are not cured by the addition of either *Wren* or *Richards*. For example, the Examiner contends that *Wren* is applied as teaching storing a data picture permanently (Office Action dated August 23, 2006, page 18, lines 1-7) and that *Richards* is applied as teaching the use of a Java applet operating within an Internet browser for conducting a data input session (Office Action dated August 23, 2006, page 18, lines 11-18).

Neither of these references, neither alone nor in and reasonable combination with any other of *Manghirmalani et al., Tuli et al., Black et al.,* or *Ferguson et al.,* disclose or suggest the features recited by claims 128 or 137, nor of any other pending claims as discussed previously.

By virtue of their dependency on allowable independent claims, dependent claims 44-52, 92-98, 100-105, 107-110, 112-120, 122-125, 127-130, 132-135, 137-140, and 142-145 are allowable for at least the same reasons as their respective independent claims, and are separately patentable on their own merits. Thus, the rejection of all pending claims should be reversed.

VIII.   <u>CONCLUSION AND PRAYER FOR RELIEF</u>

For the foregoing reasons, Appellant requests the Honorable Board to reverse each of the
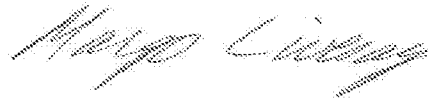
Examiner's rejections.

If necessary, please charge any additional fees or credit overpayment to Deposit Account

No. 50-3521.

Respectfully submitted,

Brake Hughes Bellermann LLP
Customer Number 53666
Phone: 202-470-6454

Date: <u>July 26, 2007</u>   By _____

Margo Livesay, Ph.D.
Reg. No. 41,946

IX.   CLAIMS APPENDIX

1-41.   (Canceled)

42. (Previously Presented) An electronic interface for collecting information for a data picture, the interface comprising:

a data palette providing a set of data parameters available for selection, said set of data parameters including at least some corresponding to predefined statements concerning an action and/or a transaction; and

a data canvas on which a selected set of one or more of said set of data parameters can be displayed and relatively positioned arbitrarily by a user to generate the data picture

wherein the data picture includes a display of a graphical relative positioning of the selected set of data parameters relative to one another, the graphical relative positioning being configured by the user within the data canvas.

43.   (Previously Presented) The interface of claim 42, wherein said selected set of data parameters can be selected and physically moved by such user to a gradient on said data canvas by physically manipulating an electronic pointing device.

44.   (Previously Presented) The interface of claim 42, wherein the data picture is generated using a single data capture screen including said data palette and said data canvas.

45.   (Previously Presented) The interface of claim 42, wherein the data picture is translatable into one or more electronic records including numeric data values.

46.   (Previously Presented) The interface of claim 45, wherein said numeric data values are based on the physical location of said selected set of data parameters as placed by the user on said data canvas.

47.   (Previously Presented) The interface of claim 42, wherein said selected set of data parameters, including individual ones of said selected group of predefined statements can be ranked in relative importance by the user based on their location on said data canvas.

48.   (Previously Presented) The interface of claim 47, further wherein said data canvas conveys visible feedback information when the user is relatively positioning said selected set of data parameters.

49.   (Previously Presented) The interface of claim 42, wherein said sets of data parameters include factors associated with lessons learned by a user concerning such action and/or transaction.

50.   (Original) The interface of claim 42, wherein said interface also provides a visual comparison between data in said data picture and other data pictures.

51.   (Previously Presented) The interface of claim 42, wherein said interface also provides visual feedback to such operator based on an evaluation of said data in the data picture.

52.   (Previously Presented) The interface of claim 42, wherein said set of data parameters can be customized by the user.

53-90. (Canceled)

91.   (Previously Presented) A computer program product comprising:

a signal bearing medium bearing at least one of

one or more instructions for providing a data palette, said palette including a set of data parameters available for selection by a user, such that said set of data parameters includes at least some corresponding to predefined statements concerning an action and/or a transaction; and

one or more instructions for providing a data canvas on which selected data parameters can be displayed and relatively positioned arbitrarily by said user to generate a data picture

wherein the data picture can be based at least in part on a graphical relative positioning of a selected group of said predefined statements collected from said user and pertaining to the user's mental impressions concerning said action and/or said transaction, said graphical relative positioning being configured by the user within the data canvas based on physical positions selected by the user within the data canvas for said predefined statements and/or a relative spatial relationship between said predefined statements within the data canvas concerning said action and/or said transaction.

APPEAL BRIEF
Page 53
Serial Number: 09/945,099
Dkt: 0006-003004
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

92.   (Previously Presented) The computer program product of claim 91, wherein information collected from said user is captured using a single data picture.

93.   (Previously Presented) The computer program product of claim 91, wherein all information for the data picture is captured during a data collection session using a single data collection screen.

94.   (Previously Presented) The computer program product of claim 91, wherein the data picture is stored as part of a transaction record which includes numeric data values.

95.   (Previously Presented) The computer program product of claim 91, wherein said numeric data values are based on the physical location of said selected data parameters as placed by the user on said data canvas.

96.   (Previously Presented) The computer program product of claim 91, further including one or more instructions for permitting said user to rank said selected data parameters, including said selected group of said predefined statements, on said data canvas.

97.   (Previously Presented) The computer program product of claim 91, wherein said selected data parameters can be ranked according to their physical arrangement on said data canvas.

98.   (Previously Presented) The computer program product of claim 91, further including one or more instructions for providing visual feedback based on an evaluation of the data picture to present the user with a visual output depicting an expected outcome of said action and/or said transaction based on the data picture.

99.   (Previously Presented) A method of permitting a user to input a data picture expressing mental impressions concerning an action and/or transaction, the method comprising:

providing a set of a plurality of individual assertions, said assertions being associated with such mental impressions; and

displaying said set of assertions to the user in a first portion of a visible electronic interface; and

permitting the user to select and move personalized individual assertions taken from said sets of assertions to a second, separate portion of said visible interface, which second separate portion acts as a data canvas for displaying such personalized individual assertions; and

wherein said personalized individual assertions can be relatively positioned by the user relative to one another within the data canvas to create the data picture.

100.   (Previously Presented) The method of claim 99, wherein all information collected from said user for the action and/or transaction is captured using a single data picture.

APPEAL BRIEF
Serial Number: 09/945,099
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 55
Dkt: 0006-003004

101.   (Previously Presented) The method of claim 99, wherein all information is captured for the action and/or transaction during a data collection session using a single data collection screen.

102.   (Previously Presented) The method of claim 99, wherein numeric data values are assigned to said personalized individual assertions based on the physical location of said personalized individual assertions as placed by the user on said data canvas.

103.   (Previously Presented) The method of claim 99, further including a step of permitting said user to rank said personalized individual assertions on said data canvas.

104.   (Previously Presented) The method of claim 103, wherein said personalized individual assertions can be ranked according to their physical arrangement on said data canvas.

105.   (Previously Presented) The method of claim 99, further including providing visual feedback based on an evaluation of the data picture to present the user with a visual output depicting an expected outcome of said action and/or said transaction based on the data picture.

106.   (Previously Presented) A method of capturing data concerning an actual or proposed transaction from the user of a computing system, said system including at least a keyboard and pointing device for inputting data, the method comprising:

providing a set of a plurality of individual assertions, said assertions being associated

with mental impressions of the user relating to the transaction; and

displaying said sets of assertions to the user in a first portion of a visible electronic

interface; and

permitting the user to select and move the selected assertions taken from said set of

assertions to a second, separate portion of said visible interface, which second separate portion

acts to display such selected assertions along a visible gradient; and

permitting the user to relatively position said selected assertions in a ranking order

relative to each other along said visible gradient to create a data picture.

107.   (Previously Presented) The method of claim 106 further wherein all information

collected from said user for the actual and/or proposed transaction is captured using said set of

assertions.

108.   (Previously Presented) The method of claim 106 further wherein all of the user's

information for the actual and/or proposed transaction is captured during a data collection

session using a single data collection screen.

109.   (Previously Presented) The method of claim 106, wherein numeric data values

are assigned to said selected assertions based on their physical location as placed by the user on

said data canvas.

APPEAL BRIEF
Serial Number: 09/945,099
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 57
Dkt: 0006-003004

110. (Previously Presented) The method of claim 106, further including a step of providing a visual comparison between the data picture and data collected from said user during a prior data capture session.

111. (Previously Presented) A method of generating program data from user input data concerning an actual or proposed action and/or transaction, the method comprising:

providing the user with a palette of individual assertions associated with the user's perceptions of such action and/or transaction in a first portion of a visible interface; and

permitting the user to select and move selected assertions taken from said set of assertions to a second, separate portion of said visible interface, which second separate portion acts to visibly display such selected assertions;

permitting the user to relatively position said selected assertions in a ranking order relative to each other so as to constitute the user input data; and

converting the user input data into program data, by assigning numerical values to such program data corresponding to said relative positioning of said selected assertions.

112. (Previously Presented) The method of claim 111, wherein said numeric data values are based on the physical location of said assertions as placed by the user on said second separate portion of said interface.

113. (Previously Presented) The method of claim 111, further including providing a gradient visible to the user for assisting in the ranking of said selected assertions.

APPEAL BRIEF
Serial Number: 09/945,099
Filing Date: August 31, 2001
Title: Interface and Method Adapted for Capturing Subjective Preferences of Program Users

Page 58
Dkt: 0006-003004

114.   (Previously Presented) The method of claim 111, further including providing visible feedback information when the user relatively positions said selected assertions.

115.   (Previously Presented) The method of claim 111, wherein said palette of individual assertions include statements associated with lessons learned by a user concerning such action and/or transaction.

116.   (Previously Presented) The method of claim 115, further including retrieving and modifying any of said lessons associated with the user input data at a later time.

117.   (Previously Presented) The method of claim 111 wherein said palette of individual assertions can be customized at least in part by the user.

118.   (Previously Presented) The method of claim 111, further including providing a visual comparison between the user input data and program data collected from said user during a prior session.

119.   (Previously Presented) The method of claim 111, further including providing visual feedback based on an evaluation of the user input data to present the user with a visual output depicting an expected outcome of said action and/or said transaction based on the user input data.

120.   (Previously Presented) The method of claim 111 further wherein all of the user's information concerning an actual or proposed transaction is captured during a data collection session using a single data collection screen.

121.   (Previously Presented) A method of capturing input data from a user within an electronic interface comprising:

(a) providing a menu within the interface for presenting a set of data parameters to the user;

(b) providing a canvas in association with the interface for creating a data record based on said set of data parameters;

(c) moving a selected data parameter from the set of data parameters to said canvas; and

(d) relatively positioning said selected data parameter on said canvas so as to indicate a corresponding weighting factor to be associated with said selected data parameter.

122.   (Previously Presented) The method of claim 121, wherein said data record is used as a query to locate additional information for the user.

123.   (Previously Presented) The method of claim 121, wherein said data record is compared against other data records in the visual analysis is presented to the user.

124.   (Previously Presented) The method of claim 121, wherein said weighting factor is based on a physical location within the interface provided by the user.

125.   (Previously Presented) The method of claim 124, wherein both a horizontal and vertical location are used to determine said weighting factor.

126.   (Previously Presented) A method of providing feedback to a user during a data input session comprising:

(a) collecting input data from the user using a data interface, said input data comprising:

i) one or more selected data parameters;

ii) weighting information identifying a corresponding weighting factor to be given to each of said one or more selected data parameters; and

(b) providing feedback information to the user while the user is providing said input data, said feedback information being based at least in part on said input data such that the user can monitor the effect of changing said one or more selected data parameters and/or their associated weighting factors based on relative positioning of each of the selected data parameters by the user.

127.   (Previously Presented) The method of claim 126, wherein said feedback information includes: (a) a set of data records correlating with said input data; (b) a list of proposed options based on said input data; (c) changes in an appearance of said data interface;

and/or (d) a prediction of expected financial return based on input data; (e) a financial

performance associated with transactions using said input data.

128.   (Previously Presented) The method of claim 126, wherein said data input session

is conducted using a Java™ applet operating within an Internet browser.

129.   (Previously Presented) The method of claim 126, wherein said data parameters

correspond to reasons, motivations or perceptions concerning a transaction and/or action by the

user.

130.   (Previously Presented) The method of claim 126, wherein said weighting factor

is based on a relative placement of said selected data parameter within the interface.

131.   (Previously Presented) A method of evaluating data records associated with an

action and/or transaction, the method comprising:

(a) storing one or more data records, each of said data records including:

i)   a set of data parameters identified by a user as pertaining to the action

and/or transaction;

ii)   a weighting factor to be given to each data parameters in said set of data

parameters based on a relative positioning of each of the data parameters by the user;

(b) processing a query by the user, said query requesting an evaluation of a frequency of

usage for a data parameter, and/or an evaluation of a rating given to a weighting factor associated

with said data parameter, across said data records or a subset thereof; and

(c) providing feedback to the user in response to said query.

132.   (Previously Presented) The method of claim 131, wherein said feedback includes

a chart and/or graph.

133.   (Previously Presented) The method of claim 132, wherein said feedback includes

a proposed model sets of data records and weighting factors.

135.   (Previously Presented) The method of claim 131, wherein said feedback includes

a financial performance associated with using said one or more data records.

136.   (Previously Presented) A method of creating a data record based on input data

from a user provided with an interface, the method comprising:

(a) generating a first data picture at a first time within the interface, said first data picture

including a first set of data parameters and associated weighting factors,

wherein said first data picture is created before the user performs an action and/or

transaction associated with said first set of data parameters;

(b) generating a second data picture at a second time within the interface, said second

data picture including a second set of data parameters and associated weighting factors based on

a relative positioning of each of the second set of data parameters by the user,

wherein said second data picture is created after the user performs said action and/or said

transaction; and

(c) modifying said second data picture at a third time within the interface using said

second set of data parameters,

wherein both said first data picture and said second picture are used to create a data

record.

137.   (Previously Presented) The method of claim 136, wherein said first data picture is

not alterable after it is created.

138.   (Previously Presented) The method of claim 136, wherein said action and/or

transaction pertains to trading a security, and said first data picture is associated with the

purchase of said security, and said second data picture is associated with a sale of said security.

139.   (Previously Presented) The method of claim 138, further including:

providing feedback to the user to indicate a financial performance associated with said

trading of said security.

140.   (Previously Presented) The method of claim 138, wherein said first sets of data parameters pertain to a motivation and/or reason of the user engaging in said action and/or transaction, and said second set of data parameters pertain to a lesson learned by the user from engaging in said action and/or transaction.

141.   (Previously Presented) A data picture record derived from data input in the form of a graphical arrangement by a user, the data picture record comprising:

an identifier indicating a particular action and/or a transaction identified by the user as related to the data input;

an identity of a data parameter selected by the user to express the data input and used in the graphical arrangement for the particular action and/or transaction; and

a weighting factor associated with said data parameter, said weighting factor being derived from a relative placement of said data parameter within the graphical arrangement.

142.   (Previously Presented) The data picture of claim 141, wherein a collection of data picture records are grouped for said action and/or transaction.

143.   (Previously Presented) The data picture of claim 142, wherein said collection data picture records include data picture records created before said action and/or transaction, and data picture records created after said action and/or transaction.

144.   (Previously Presented) The data picture of claim 141, wherein said weighting

factor is based on a physical coordinate location within a data canvas.

145.   (Previously Presented) The data picture of claim 144, wherein both a horizontal

position and a vertical position are considered in determining said weighting factor.

X.   EVIDENCE APPENDIX

Appellant is unaware of any evidence that is required to be submitted in the present Evidence Appendix.

XI.   <u>RELATED PROCEEDINGS APPENDIX</u>

Appellant is unaware of any related proceedings that are required to be submitted in the present Related Proceedings Appendix.